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OFFICE OF PETITIONS

In re Application of :
Hideaki TAKAHASHI :
Application No. 10/707,589 :
Filed: December 23, 2003 :
Attorney Docket No. SIMTEK6715 :

ON PETITION

This is a decision on the petition filed September 12, 2006 under 37 CFR 1.181(a)(3) requesting the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 2800 (Technology Center Director), dated September 2, 2006, which refused to: (1) withdrawal the holding of abandonment; and (2) enter the amendment filed August 6, 2006.

The petition to overturn the decision of the Technology Center Director dated September 12, 2006, is **DENIED**¹.

BACKGROUND

The instant application was filed December 23, 2003.

A non-final Office action was mailed July 21, 2005.

An amendment was filed August 20, 2005 and supplemented on November 11, 2005.

On January 25, 2006 a final Office action was mailed.

On January 26, 2006 a petition to invoke supervisory authority was filed.

On August 1, 2006 a decision granting the petition filed January 26, 2006 was mailed.

On August 6, 2006 an amendment and petition requesting entry of such amendment was filed.

On September 2, 2006 a decision denying the petition of August 6, 2006 was mailed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. 133 states:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.135 states:

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

OPINION

Petitioner specifically requests that the Director overturn the Technology Center Director's decision of September 2, 2006 and (1) withdrawal the holding of abandonment; and (2) enter the amendment filed August 6, 2006.

A final Office action was mailed in the instant application on January 25, 2006. Petitioner filed a petition to withdraw the finality of the January 25, 2006 Office action on January 26, 2006. A decision granting the January 26, 2006 petition was mailed August 1, 2006. The petition decision stated "...prosecution on the merits of the instant

application is not closed, and any response to the 1/25/06 office action will be considered as a response to a non-final of action."

Petitioner argues that the August 1, 2006 petition decision reopened prosecution and set a new period for response due the Office's delay and thus the August 6, 2006 response should be considered timely.

Initially it is noted that the petition decision of August 1, 2006 does not state that a new period for response to the January 25, 2006 Office action has been set due to Office delay. As stated in 37 CFR 1.135(b): "Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment." Additionally, 37 CFR 1.181(f) states: "The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings." Petitioner filed no timely amendment to save the application from abandonment within the time period provided in the January 25, 2006 Office action. In fact petitioner filed no amendment until August 6, 2006, after the petition decision of August 1, 2006. Since the filing of the petition on January 26, 2006 did not toll the time for filing a response and the amendment filed August 6, 2006 was filed outside the period for reply to the January 25, 2006 Office action the application has been properly held abandoned.

For the reasons set forth above, the Technology Center Director's decision to refuse petitioners' requests to: (1) withdrawal the holding of abandonment; and (2) enter the amendment filed August 6, 2006 is not shown to be in clear error.

DECISION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of September 2, 2006. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of September 2, 2006 has been reviewed, but is denied with respect to making any change therein. As such, the decision of September 2, 2006 will not be disturbed. The petition is **denied**.

Petitioner may wish to consider filing a petition under 37 CFR 1.137(a) or (b) to revive the application.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.



John J. Love
Deputy Commissioner for
Patent Examination Policy

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¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02